



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Laurence POLLET et al.

Group Art Unit: 1794

Application No.: 10/579,232

Examiner: N. EDWARDS

Filed: June 8, 2006

Docket No.: 127964

For: COMPOSITE YARN COMPRISING A FILAMENT YARN AND A MATRIX
COMPRISING A FOAMED POLYMER

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the September 22, 2008 Restriction and Election of Species Requirement,

Applicants provisionally elect Group I, claims 1–15, and elect as a Species the following:

- the filament yarn is made of glass (inorganic material);
- the polymer material for the first and second matrices is polyvinyl chloride; and
- the flame retardant filler is zinc hydroxystannate

with traverse. At least claims 1–4, 7–9, and 15 read on the elected species. At least claim 1 is generic.

PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or

more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. *See MPEP §1850(II)*, quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Furthermore, unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims, as stated in ISPE 10.06:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

See also MPEP §1850(II).

Each of independent claims 1, 15, 16, 17, 18, 19, 20, and 21 at least requires a composite yarn comprising a filament yarn coated with a polymeric material containing a foaming system. Accordingly, all the claims share common subject matter and, therefore, a

priori unity of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements common to the independent claims are known. *See* ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of the subject matter that is common to the independent claims is known in the prior art. The Office Action alleges that U.S. Patent Nos. 3,916,060; 6,630,231; 6,986,854; 7,364,788; and 7,381,447 each shows fibers uniformly distributed in a polymeric matrix. However, the Office Action fails to establish that any of the cited references discloses a composite yarn comprising a filament yarn coated with a polymeric material containing a foaming system. Therefore, Applicants respectfully submit that a lack of unity of invention has not been established, and thus the restriction requirement between the independent claims is improper.

Furthermore, Applicants respectfully submit that the species election requirement is also improper under PCT Rule 13. In general, a species election requirement is not allowed under PCT Rule 13 for generic independent claims and their dependent claims. Restriction between different embodiments (species) of an invention encompassed by a single independent claim is only proper under PCT Rule 13 if the claim expressly recites distinct embodiments (such as a Markush group) and the Office Action establishes that the distinct embodiments share no common subject matter that defines a contribution over the prior art. *See* ISPE 10.09; MPEP §1850(II). In this case, claim 1 only recites alternatives for the filament yarn being made of inorganic or organic materials, but, for the reasons discussed above, the Office Action fails to establish that claim 1 lacks a special technical feature. Therefore, the requirement to elect between organic and inorganic materials is clearly improper. Additionally, claim 1 does not recite alternatives for specific inorganic or organic materials, or specific polymeric materials, and does not even mention flame retardants.